

17-19, 21, and 30 (respectively) of U.S. Patent No. 6,088,682. A terminal disclaimer is being submitted herewith. Thus it is respectfully requested that this rejection be withdrawn.

Reconsideration is respectfully requested of the rejection of claims 1-15, 17-19, 21, and 31 under 35 U.S.C. 103(a) as being unpatentable over Winn-Dixie ("Winn-Dixie and the Salvation Army Team Up to Fight Hunger Across the Sunbelt," PR Newswire, January 9, 1989) in view of Fukatsu (US 5,302,811).

The claims are believed to be distinct and non-obvious from any of the references, alone or in combination, by virtue of "entering means for entering an identifier that identifies the transactor; applying means responsive to said remote input and said identifier entering means for applying at least a part of the excess to an account predetermined on the basis of said identifier; and said account being identified independent of data in the remote input." in claims 1 to 12, 21, 32, 33, 36, 37, 40, 42, 44, 45, 48, 49, and 52; by virtue of "applying at least a part of the excess to an account as determined by the card identifier; and crediting the excess to the account in the card identifier; the account being identified with said card identifier being independent of said remote input." in claims 13 to 19, 34, 35, 38, 39, 41, 43, 46, 47, 50, 51, and 53; and by virtue of "a processor remote from said entry station and responsive to said card reader or keyboard for applying at least a part of the excess to an account or accounts on the basis of said identifier of said transactor; and said account or accounts being identified independent of data in the remote input." in claim 31.

The dependent claims are believed more specifically to be distinct and non-obvious from any of the references, alone or in combination, by virtue of the particular features recited therein.

None of the references, alone or in combination, suggests these features nor in any sense makes the claimed subject matter obvious. In Winn-Dixie the excess always goes into same single account, "Even It Up for the Hungry" on the basis of a selection by the merchant, Winn-Dixie to use with the single non-profit, the Salvation Army. The merchant chooses the single account.

By contrast, in the present claims, the account, which receives the excess, is determined by the payor on the basis of the payor's identifier and the account is independent of the knowledge of the merchant and independent of what is entered in the remote input. It is the account that is predetermined on the basis of the identifier of the payor. Each identifier and payor is associated with a particular account.

In Winn-Dixie there is no identifier for the customer, and there is no specified account for the customer. It is the merchant, Winn-Dixie, that makes the choice of the charity.

The Examiner alleges that Fukatsu discloses a keyboard or card reader for receiving an identifier that identifies a transactor in the transaction. However, Fukatsu's keyboard and card reader add nothing to Winn-Dixie to make the aforementioned claim language obvious. There would be no place in Winn-Dixie for an identifier. Winn-Dixie is a system that has no intention of keeping track of individual customer donations or depositing to any account but that selected by the merchant. There would be nothing to suggest record keeping for the customer because **the merchant has total control**. The two are incompatible.

It is well established that identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. As set forth by U.S. Court of Appeals, Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 217 F.3d 1365 (Fed. Cir.

06/30/2000):

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the

teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

In *Ex parte Metcalf*, 67 USPQ2d 1633 (BdPatApp&Int 2003), U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences stressed that point when it reversed the examiner, stating:

"Specifically, the mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious 'absent some teaching, suggestion or incentive supporting the combination.' " *Carella*, 804 F.2d at 140, 231 USPQ at 647 (citing *ACS Hosp. Sys., Inc.*, 732 F.2d at 1577, 221 USPQ at 933).

In the present references there is no hint or motivation for Winn-Dixie to use Fukatsu's card reader. Winn-Dixie has no intention of keeping track of individual customer donations or depositing to any account but that selected by the merchant. Winn-Dixie and Fukatsu teach away from each other.

As to Claims 2 and 15 the Examiner alleges that Winn-Dixie and Fukatsu disclose applying means includes apportioning means for apportioning at least part of the excess of predetermined accounts to one or more accounts selected from a plurality of accounts. Applicant cannot agree. Neither Fukatsu nor Winn-Dixie hints at selection of multiple accounts for each payor.